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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,155	12/16/2005	Seiji Mizohata	Q91918	9130
23373 7590 12/18/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
GRAY, JILL M				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
12/18/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/561,155

Applicant(s)

MIZOHATA ET AL.

Examiner

Jill Gray

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS-08)
Paper No(s)/Mail Date 06/04/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Pursuant to the entry of the amendment of August 12, 2009, the status of the claims is as follows: Claims 1, 3-5, and 8-10 are pending. Claims 1 and 3-5, have been amended. Claims 2, 6-7, and 11-20 have been cancelled.

Response to Amendment

2. The rejection of claims 1, 6-8, and 15 under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication EP 0 821 086 is moot in view of applicants' amendments.
3. The rejection of claims 9-10 and 17 under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication EP 0 821 086 in view of Azuse et al., US 2003/0024052 A1 is moot in view of applicants' amendments.
4. The rejection of claim 16 under 35 U.S.C. 103(a) as being unpatentable over EP 0 821 086 in view of Azuese et al., US 2003/0024052 A1 further in view of Japanese Patent Publication abstract JP 62-243873 is moot in view of applicants' amendments.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication EP 0 821 086 (the publication) in view of Japanese Patent Publication JP 62-243873 abstract (the abstract).

The publication discloses a polyether ester elastic fiber of the type contemplated by applicants containing a polyether ester elastomer containing polybutylene terephthalate hard segments and polyoxyethylene glycol soft segments, per claim 1. See entire document, and for example, page 3, line 55 and page 4, line 2. The publication also discloses that the hard segments and soft segments are present in amounts within the instant claimed range as required by claims 8 and 15. See page 8, lines 28-31. Regarding properties such as the coefficient of moisture absorption and water absorption (claim 1) the polyether ester elastic fiber of the prior art is substantially the same as that contemplated by applicants, accordingly it is the examiner's position that these properties of the prior art fiber are the same as or substantially similar as well in the absence of factual evidence to the contrary. Applicants are invited to provide such evidence.

The publication is as set forth above but does not teach the polyether ester elastomer copolymerized with a metal organic sulfonate. The abstract teaches deodorizing polyester fibers comprising a polyester copolymerized with a metal sulphonate, wherein the preferred polyesters include polybutylene terephthalate. It would have been obvious to the skilled artisan to modify the teachings of the publication by copolymerizing the metal sulfonate to produce an elastic fiber having a good deodorizing effect.

Therefore, the combined teachings of the publication and the abstract would have rendered obvious the invention as claimed in present claims 1, 3-5 and 8-10.

Response to Arguments

2. Applicant's arguments filed August 12, 2009 have been fully considered but they are not persuasive.

Applicants argue that there is no teaching, suggestion, motivation, or other reason to combine the publication with the abstract.

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching in the abstract of obtaining a good deodorizing effect would have provided motivation to the skilled artisan to copolymerize the polyether ester elastomer with a metal organic sulfonate.

Applicants argue that neither the abstract nor the publication teach a polyether ester elastic fiber having the properties of providing good moisture-absorbing property, is reversibly largely expanded or contracted by the absorption or release of water, or that a woven or knitted fabric would have the so-called self-adjusting function when the fabric absorbs sweat.

In this regard, the combined teachings of the publication and the abstract clearly suggest a polyether ester elastomer with a metal organic sulfonate. Accordingly, the product of the prior art is substantially the same as that contemplated by applicants and

the skilled artisan would have reason to believe that the properties are the same as well. There is no clear factual evidence on this record to substantiate applicants' arguments that the prior art fiber does not have the argued properties.

No claims are allowed.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill Gray/
Primary Examiner
Art Unit 1794

jmg